

REMARKS

I. Status of the Claims

In the Office Action of June 3, 2011 (the "Office Action"),¹ the Examiner took the following actions:

- i) objected to the drawings under 37 C.F.R. 1.83(b) as allegedly being incomplete;
- ii) rejected claims 1-56 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement;
- iii) rejected claims 1-56 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement;
- iv) rejected claims 1-4, 6-9, and 11-56² under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/10021307 to Glenn et al. ("*Glenn*") in view of U.S. Patent No. 5,948,058 to Kudoh et al. ("*Kudoh*") further in view of U.S. Patent No. 6,081,830 to Schindler ("*Schindler*") and further in view of U.S. Patent No. 7,149,208 to Mattaway et al. ("*Mattaway*");
- v) rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Glenn*, *Kudoh*, *Schindler*, *Mattaway*, and further in view of U.S. Publication No. 2010/0184517 to Danieli et al. ("*Danieli*");
- vi) rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Glenn*, *Kudoh*, *Schindler*, *Mattaway*, and further in view of U.S. Patent No. 7,076,546 to Bates et al. ("*Bates*"); and
- vii) rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Glenn*, *Kudoh*, *Schindler*, and further in view of U.S. Patent No. 6,446,112 to Bunney et al. ("*Bunney*").

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action states that "claims 1-4, 6-9, 11-68, and 71-80" are rejected. Office Action, p. 5. However, only claims 1-56 are pending in the present application. Therefore, Applicant interprets the rejection to reject claims 1-4, 6-9, and 11-56.

Claims 1-56 are pending in this application. Applicant respectfully traverses the rejections and submits that the pending claims are in condition for allowance for at least the following reasons.

II. Objection to the Drawings under 37 C.F.R. 1.83(b)

Applicant respectfully traverses the objection to the drawings under 37 C.F.R. 1.83(b). The drawings meet all of the applicable requirements of 37 C.F.R. 1.83 and the objection should be withdrawn.

As an initial matter, 37 C.F.R. 1.83(b) relates to an "invention [that] consists of an improvement on an old machine..." The claims of the present application do not merely recite an improvement on an "old machine." Moreover, 37 C.F.R. 1.83(b) is inapplicable to the pending claims and, for at least this reason, the objection should be withdrawn.

Further, regardless of the applicability of 37 C.F.R. 1.83(b) to the present invention, the drawings comply with all requirements, including those of section 1.83(a). The Office Action asserts that the drawings fail to show, "wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient," as recited in independent claim 1. Applicant respectfully disagrees. In Fig. 8, for example, method 800 is illustrated with steps 835, 840, 845, and 850.

The Office Action further asserts that the drawings fail to show, "e-mail message comprises an invitation to join the communications system," as recited in claim 5.

Applicant respectfully disagrees. Fig. 10, for example, illustrates an exemplary user interface with which a user to invite a contact who is not an AIM user to join the AIM network by accessing the contact's email address (i.e. "sallysmith@stratsight.com") and sending an email invitation to use AIM.

The Office Action further asserts that the drawings fail to show, "the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message," as recited in claim 7. Applicant respectfully disagrees. By way of example, the Examiner's attention is again directed to Fig. 10. The exemplary user interface of Fig. 10 is shown with an icon that is positioned next to e-mail addresses in an e-mail message (e.g., "cbarker@asia.com"; "alisa@netscape.com"; "jsruhl@aol.com"; "bmaylor@aol.com").

In view of the foregoing, the drawings adequately show all the claimed elements and satisfy the applicable requirements under 37 C.F.R. 1.83. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to the drawings.

III. Rejection of Claims 1-56 under 35 U.S.C. § 112, First Paragraph (Written Description)

Applicant respectfully traverses the rejection of claims 1-56 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. The Office Action asserts that the specification fails to describe, "wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state

of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient," as recited in independent claim 1. Applicant respectfully disagrees.

By way of example, Fig. 8 illustrates an embodiment for the above claimed subject matter of claim 1. Furthermore, Applicant's specification describes "the e-buddy server 6392 strips the domain (e.g., @aol.com) from the e-mail address of a subscriber with a recognized domain to obtain the subscriber's screen name (step 835). This step facilitates the reverse look-up process. The e-buddy server 6392 sends the listing of e-mail addresses to the look-up server 6394. The look-up server determines the instant messaging capability of each of the e-mail addresses and/or screen names (step 840)." Specification, p. 19, ll. 17-24. Therefore, the written description requirement is satisfied as to the above subject matter of claim 1.

The Office Action further asserts that the specification fails to describe, "e-mail message comprises an invitation to join the communications system," as recited in claim 5. Applicant respectfully disagrees.

By way of example, Fig. 10 illustrates an embodiment for the above claimed subject matter of claim 5. Furthermore, Applicant's specification teaches "[a] user may send an e-mail message to the person by clicking the bracketed e-mail address. The e-mail message may include, for example, an invitation and/or instructions for obtaining instant messaging capability." Specification, p. 21, ll. 20-23. Therefore, the written description requirement is satisfied as to the above subject matter of claim 5.

The Office Action further asserts that the specification fails to disclose, "the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message," as recited in claim 7. Applicant respectfully disagrees.

By way of example, Fig. 10 illustrates an embodiment for the above claimed subject matter of claim 7. Furthermore, the specification teaches, "[a]n icon next to a person's address in an e-mail message may indicate to the recipient that the person has IM capability." Specification, p. 21, ll. 26-27. Therefore, the written description requirement is satisfied as to the above subject matter of claim 7.

In view of the foregoing, the specification provides an adequate written description for claims 1-56. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claims 1-56 under 35 U.S.C. § 112, first paragraph.

IV. Rejection of Claims 1-56 under 35 U.S.C. § 112, First Paragraph (Enablement)

Applicant respectfully traverses the rejection of claims 1-56 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. As evident from at least the above-referenced sections of the drawings and specification, all the claim elements are fully supported and enabled by Applicant's specification. Therefore, the specification satisfies the enablement requirement and Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claims 1-56 under 35 U.S.C. § 112, first paragraph.

V. Rejection of Claims 1, 4-7, 11-20, 22, 25, and 27-34 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1, 4-7, 11-20, 22, 25, and 27-34 under 35 U.S.C. § 103(a) as being unpatentable over the asserted combination of *Glenn, Kudoh, Schindler, and Mattaway*. A *prima facie* case of obviousness has not been established with respect to Applicant's claims.

In the Office Action, the Examiner has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See MPEP § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Independent claim 1, for example, recites a method for transferring electronic data between users of a communications system comprising, among other things, "wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient." *Glenn, Kudoh, Schindler, and Mattaway*, alone or in any proper combination, fail to teach or suggest at least the above subject matter of independent claim 1.

The Office Action correctly acknowledges that *Glenn, Kudoh, and Schindler* fail to teach the claimed "wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain

name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient.” Office Action, pp. 6-7. However, the Office Action asserts that *Mattaway* corrects the deficiencies of *Glenn, Kudoh*, and *Schindler* with respect to this subject matter of claim 1. *Id.* This assertion is incorrect.

Mattaway relates to the interaction between WebPhone (WPP) clients and a global server. *Mattaway*, p. 23, ll. 6-67. According to *Mattaway*, the global server allows for the transfer of data packets to and from the WebPhone based on whether the WebPhone is online and available to make/receive calls. *Id.* If the current dynamically assigned IP address of a callee is unknown, the WebPhone user can use the callee's email address to obtain the IP address. *Mattaway*, p. 24, ll. 1-10. The connection server utilizes the value of the email address to perform a one-to-one mapping in an online table to determine the current IP address of the callee. *Mattaway*, p. 24, ll. 20-25. Based on the state of the callee, a <CONNECT ACK> packet is received by the WebPhone user if the connection is successful, or an <OFFLINE> packet is received if the callee is offline. *Mattaway*, p. 24, ll. 26-38.

However, *Mattaway* fails to include an teaching or suggestion of “wherein indicating the online state comprises: **determining an identity** of one or more of the sender or any one other recipient **by stripping a domain name from an email address** associated with the one or more of the sender or any one other recipient, and **determining the online state** of the one or more of the sender or any one other recipient **by performing a reverse look-up with the determined identity** of the one or

more of the sender or any one other recipient," as recited in claim 1 (emphasis added). For at least the above reasons, *Glenn, Kudoh, Schindler, and Mattaway* fail to teach or suggest, either alone or in combination, all of the subject matter of independent claim 1. Therefore, the rejection of claim 1 should be withdrawn and claim 1 should be allowed.

Danieli, Bates, and Bunney fail to compensate for the deficiencies of *Glenn, Kudoh, Schindler, and Mattaway* with respect to the above subject matter. That is, *Danieli, Bates, and Bunney* do not teach or suggest at least "wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient," as recited in independent claim 1.

Independent claims 18, 23, and 26, while of different scope, distinguish over *Glenn, Kudoh, Schindler, and Mattaway* for at least similar reasons as that presented above for claim 1. Accordingly, the rejection of claims 18, 23, and 26 should be withdrawn and these claims should be allowed.

Claims 2-17, 19-22, 24, 25, and 27-56 distinguish over *Glenn, Kudoh, Schindler, and Mattaway* at least due to their dependence from one of the allowable independent claims. Furthermore, claims 2-17, 19-22, 24, 25, and 27-56 are allowable over the art of record in view of the additional features recited by these claims.

Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-56 under 35 U.S.C. § 103(a).

CONCLUSION

Applicant respectfully requests reconsideration and withdrawal of the rejections, and timely allowance of the pending claims for at least the reasons set forth below.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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